



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,891	02/02/2001	Eric A. Baldwin	04608.00002	8122

22908 7590 01/29/2003

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
----------	--------------

3743

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,891

Applicant(s)

BALDWIN ET AL.

Examiner

Kathryn Ferko

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 18,34,36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-33, 35 and 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3743

DETAILED ACTION

This is a response to the response dated December 5, 2002. Claims 1-17, 19-33, 35, and 38-41 are pending.

Election/Restrictions

Claims 18 and 34 have been withdrawn from consideration in paper #7. The subject matter of claims 18 and 34 has been incorporated into the independent claims.

Claims 36-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. Applicant elected Group I.

Specification

1. The disclosure is objected to because of the following informalities: page 10 makes reference to a figure 5 when it should reference either figure 5A or 5B.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 3, 4, 7, 8, 19, 20, 24, 25, 32, and 35 recite the limitation "the body".

There is insufficient antecedent basis for this limitation in the claims.

4. Regarding claim 32, the phrase "claw-like" or phrases "or the like" render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed

Art Unit: 3743

(those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-11, 16-17 and 19-27, and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dall et al. in US Patent No. 5,665,089.

With regard to claims 1-11, Dall et al. disclose an apparatus having a connector (36b) with a superior end and an inferior end, at least a lateral side, a medial side opposite the lateral side, an anterior, and a posterior side opposing the anterior side, as seen in figure 9; at least one claw (90) at the superior end; at least one cable aperture (48) or surface groove along the connector extending from one side to another side of the connector, as recited in column 4, lines 40-45; at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as recited in column 4, lines 3-28 and seen in figure 9; a superior end with a first transition portion that is detachable from a second transition portion of the inferior end, as recited in column 5, lines 5-12 and seen in figure 9; an inferior end that is bowed or rotated to more properly align with a bone of a body, as recited in column 3, lines 65-67; a connector that includes a transition portion between the inferior end and the superior end to

allow bending of the connector to more properly align with a bone of a body, as stated in column 5, lines 10-12 and seen in figure 10 (wherein most material can be bent to conform to the shape of a bone); a bone screw slot (44) that is located along the inferior end, as seen in figure 9; a bone screw slot that is a compression type slot, as seen in figures 9 and 10; at least one bone screw (38, 58 and/or 68) that is engageable within the bone screw slot and within a bone of a body, as seen in figure 2; a bone screw slot that is configured to angle a bone screw when it is inserted into the bone screw slot to avoid a prosthesis in a body, within the scope given the structure; a superior end that includes a cable aperture (wherein the connection portion where 36b and 90 meet there are cable apertures as seen in figure 10, therefore considered part of the superior end); a cable aperture that is angled or on a curved path relative to the anterior and posterior sides of the superior end, as recited in column 4, lines 15-25 (also any degree even 90 degrees can be considered an angle); and a cable (64) insertable within the cable aperture, as seen in figures 9 and 10.

Regarding claims 16-17 and 19-27, Dall et al. disclose an apparatus having a connector (36b) having a superior end and an inferior end, a lateral side, a medial side opposite the lateral side, an anterior side, and a posterior side opposing the anterior side; at least one cable aperture (48) along the connector, as seen in figures 9 and 10; at least one cable aperture (48) or surface groove along the superior end (wherein the connection portion where 36b and 90 meet there are cable apertures as seen in figure 10, therefore considered part of the

Art Unit: 3743

superior end); at least one claw member (90) at the superior end, as seen in figure 9; a superior end with a first transition portion that is detachable from a second transition portion of the inferior end, as recited in column 5, lines 6-13 and seen in figures 9 and 10; an inferior end that is bowed or rotated to more properly align with a bone of a body, as recited in column 3, lines 65-67; a transition portion between the inferior end and the superior end to allow bending of the connector to more properly align with a bone of a body (wherein most material can be bent to conform to the shape of a bone); at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as seen in figures 2 and 9; a bone screw slot that is located along the inferior end, as seen in figure 9; a bone screw slot that is a compression type slot, as seen in figures 9 and 10; at least one bone screw (38, 58, and/or 68) engageable within the bone screw slot (44) and within a bone of a body, as recited in column 4, lines 5-29; a bone screw slot (44) that is configured to angle a bone screw when it is inserted into the bone screw slot to avoid a prosthesis in a body, within the scope given the structure; a cable aperture (48) that is angled relative to a lateral side of the superior end, as stated in column 4, lines 15-20 (also any degree even 90 degrees can be considered an angle), and a cable (64) that is insertable within the cable aperture, as seen in figure 9.

With regard to claims 38-41, Dall et al. disclose a connector (36b) having a superior end with a first portion; an inferior end with a second portion (90) that is detachable mated to the first portion of the superior end, the inferior end

Art Unit: 3743

having at least a lateral side, a medial side opposite the lateral side, an anterior, and a posterior side opposing the anterior side, as seen in figures 9 and 10; at least one claw (90) at the superior end, as seen in figure 9; at least one cable aperture (48) or surface groove along the connector extending from one side to another side of the connector, as seen in figure 9; at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as seen in figure 2; and an inferior end and a superior end that are mated by at least one bone screw, as seen in figure 9.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-15, 28-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dall et al.

Dall et al. disclose the invention as claimed with the exception of at least one cable screw slot along the connector extending from the lateral side to the cable aperture; at least one cable screw each engageable with the respective cable screw slot and capable of crimping within the cable aperture; a driver slot along the lateral side of the superior end; and a driver engageable with the driver slot. On the other hand, Dall et al. also teach to crimp the cable, in column 4. Therefore, the crimping method of Dall et al. can be considered an equivalent

method for securing the cables. Furthermore, it would also be obvious to one with ordinary skill in the art to further provide a driver slot along the lateral side of the superior end and a driver engageable with the driver slot.

Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 4,651,724; US Patent No. 5,015,248; US Patent No. 5,702,399; US Patent No. 5,741,259; US Patent No. 5,766,218; US Patent No. 5,797,916; US Patent No. 6,066,141; US Patent No. 6,338,734; and US Patent No. 6,508,819.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KF
January 22, 2003


Henry Bennett
Supervisory Patent Examiner
Group 3700